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MAY 03 2010

OFFICE OF PETITIONS

In re Application of	:	
Zhu	:	DECISION ON APPLICATION
Application No. 10/726,812	:	FOR PATENT TERM ADJUSTMENT
Filed: December 2, 2003	:	
Attorney Docket No. 019680-007800US	:	

This is in response to the "Request for Reconsideration of Patent Term Adjustment Under 37 C.F.R. § 1.705(b)" filed May 12, 2009. Applicant requests the initial determination of patent term adjustment be corrected from zero (0) days to four hundred thirty-seven (437) days.

The application for patent term adjustment is **granted to the extent indicated herein**.

The Office has updated the PALM screen to reflect changes to the patent term calculation. However, the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance remains 0 days. A copy of the updated PALM screen is enclosed.

On February 13, 2009, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) in the above-identified application. Applicant was advised of a patent term adjustment to date of 0 days. In response, applicant timely filed this application for patent term adjustment with the issue fee on May 12, 2009.

Applicant requests the patent term adjustment be corrected to 437 days.

Applicant contends the mailing of the August 28, 2008 Office action should have resulted in an 89-day increase in patent term adjustment is appropriate under 37 C.F.R. § 1.703(a)(3).

As stated in 37 C.F.R. § 1.703(a)(2), Office delay under 37 C.F.R. § 1.702(a) includes,

The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

An amendment was filed January 31, 2008. An Office action under 35 U.S.C. § 132 was mailed on May 12, 2008, within four months after the date the amendment was filed. Therefore, an

increase in patent term adjustment due to Office delay in responding to the amendment would be inappropriate.

The Office recognizes the examiner subsequently mailed a new Office action and restarted the period for reply. However, the mailing of the new Office action does not change the fact an Office action under 35 U.S.C. § 132 was mailed within four months of the filing of the January 31, 2008 amendment.

For the reasons above, the Office acted properly when the Office did not increase the patent term adjustment as a result of the mailing of the August 28, 2008 Office action.

Applicant contends the filing of an amendment on November 24, 2008, should not have resulted in a reduction in patent term adjustment.

Applicant filed an amendment on November 24, 2008. Although the date of November 24, 2008, is less than three months after the date the Office mailed the August 28, 2008 Office action, the date is three months and 104 days after the Office mailed the May 12, 2008 Office action.

The Office entered a 104-day reduction in patent term adjustment as a result of the amendment filed November 24, 2008.

37 C.F.R. § 1.704(b) provides for a reduction when a party takes more than 3 months to respond to any notice or action by the Office making any rejection, objection, argument or other request. Specifically, 37 C.F.R. § 1.704(b) states,

[A]n applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

In view of all the facts in this case, the three-month time period set forth in 37 C.F.R. § 1.704(b) began August 28, 2008, not May 12, 2008. The November 24, 2008 amendment was filed within three months of the Office mailing the August 28, 2008 Office action. Therefore, a reduction in patent term adjustment under 37 C.F.R. § 1.704(b) is unwarranted.

The Office has removed the 104-day reduction in patent term adjustment resulting from the filing of the November 24, 2008 amendment.

A review of the record indicates an additional adjustment to the patent term adjustment is appropriate as a result of papers filed November 30, 2007, and January 31, 2008.

The Office mailed a final Office action on August 2, 2007. Applicant filed a Request for Continued Examination ("RCE") and an amendment on November 30, 2007. The Office mailed a Notice of Non-Compliant Amendment on January 25, 2007. Applicant filed a proper amendment on January 31, 2007. The Office did not enter a reduction to patent term adjustment under 37 C.F.R. § 1.704(c)(7).

37 C.F.R. § 1.704(c)(7) states circumstances that will result in a reduction in patent term adjustment include,

Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed.

Manual of Patent Examining Procedure § 2732 states,

The reference to 37 CFR 1.135(c) is parenthetical because 37 CFR 1.704(c)(7) is not limited to Office actions under 37 CFR 1.135(c) but applies when the Office issues any action or notice indicating that a reply has an omission which must be corrected: e.g., (1) a decision on a petition under 37 CFR 1.47 dismissing the petition as lacking an item necessary to grant the petition; or (2) a notice indicating that the computer readable format sequence listing filed in reply to a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (PTO-1661) does not comply with 37 CFR 1.821 et seq.

A review of the record indicates the reply filed November 30, 2007, failed to comply with the rules. As a result, the Office was required to mail a Notice of Non-Compliant Amendment and wait for, and process, the January 31, 2008 reply prior to further consideration of the merits of the case. Therefore, a reduction under 37 C.F.R. § 1.704(c)(7) is appropriate.

The proper reduction is 62 days which is the number of days beginning November 30, 2007, the day after the date a reply with an omission was filed, and ending on January 31, 2007, the date a reply correcting the omission was filed.

In view of the prior discussion, the Office has entered a 62-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(7).

Applicant asserts a 363-day increase in patent term adjustment is appropriate pursuant to 37 C.F.R. § 1.702(b).

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See 37 C.F.R. § 1.702(b). (This is true even when a request for continued examination has been

filed). The computer will not undertake the 37 C.F.R. § 1.702(b) calculation until the actual date, not just the projected date, of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 C.F.R. § 1.702(a)(4) or applicant delay under 37 C.F.R. § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 C.F.R. § 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, the Office will not consider the request at this time.

Rather than file an application for patent term adjustment under 37 C.F.R. § 1.705(b) contesting the 37 C.F.R. § 1.702(b) calculation at the time of the mailing of the notice of allowance, an applicant may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 C.F.R. § 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 C.F.R. § 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 C.F.R. § 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee.¹

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 C.F.R. § 1.705(d) and must include payment of the required fee under 37 C.F.R. § 1.18(e).

Conclusion

The Office has removed the 104-day reduction in patent term adjustment resulting from the filing of the November 24, 2008 amendment.

The Office has entered a 62-day reduction under 37 C.F.R. § 1.704(c)(7) as a result of applicant filing a paper with an omission on November 30, 2007.

The Office acknowledges submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e) for consideration of the application for patent term adjustment under 37 C.F.R. § 1.705(b).

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The patent term adjustment at the time of mailing of the notice of allowance is 0 days which is which is 303 days of Office delay reduced by 380 days of applicant delay.

Applicants are reminded that any delays by the Office pursuant to 37 C.F.R. §§ 1.702(a)(4) and 1.702(b) and any applicant delays under 37 C.F.R. § 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is written over the printed name.

Anthony Knight
Director
Office of Petitions

Enclosure: Copy of REVISED PALM screen

Day : Friday
Date: 4/30/2010

PALM INTRANET

Time: 15:22:45

PTA Calculations for Application: 10/726812

Application Filing Date:	12/02/2003	PTO Delay (PTO):	303
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	422
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	42		

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68	08/28/2008	MAIL NOTICE OF RESTARTED RESPONSE PERIOD			
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		CONSIDERED			
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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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